

REMARKS

The Specification has been amended. Claims 1 and 14 have been amended. Claim 25 has been added. No new matter has been introduced with these amendments or added claim, all of which are supported in the application as originally filed. Claims 2 - 13, 17, and 19 were previously cancelled from the application without prejudice. Claims 1, 14 - 16, 18, and 20 - 25 are now in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, and claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Objection to the Claims

Paragraph 2 of the Office Action dated July 13, 2010 (hereinafter, “the Office Action”) states that Claim 14 is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Paragraph 2 further states “The limitation of a timer [as recited in Claim 14] can be interpreted as a calendar ... i.e., from the present to the time the event occurs is a type of timer ...”.

Applicants wish to note that Claim 1 (from which Claim 14 depends) does not recite evaluating a timer. Instead, Claim 1 recites scheduling time on a calendar. With reference to an example in Applicants' Specification, an event that might be desired "when the subscription filter is matched" is to schedule a 30-minute time period on the user's calendar because "the user might like to take some time to review details of a new mobile computing device offering that has been detected using his/her subscription filter".¹ (This scheduling of time on the calendar might comprise, by way of example, adding a 30-minute "do not disturb" event on the user's calendar from 10 a.m. to 10:30 a.m., although the Specification does not state a sample time of day.) This scheduling time from Claim 1 is not the same as evaluating a timer, and in sharp contrast to the assertion in paragraph 2 of the Office Action, Claim 14 therefore does further limit the subject matter of Claim 1.

In addition, in the interest of progressing rapidly to issuance, Applicants have amended Claim 14 with intent of clarifying that the timer recited in Claim 14 is not the electronic calendar which is recited in Claim 1. In particular, Claim 14 is amended to recite "... the subsequently evaluating is invoked responsive to expiration of a timer which operates independently of the electronic calendar of the user" (emphasis added). Because the claim language explicitly states that the timer operates independently of the electronic calendar, it is clear that the timer and the electronic calendar are not the same thing. Accordingly, Applicants respectfully submit that Claim 14 as currently presented addresses the concerns discussed in paragraph 2 of the Office Action.

¹ See paragraph [0061] of Applicants' Specification, where this example is discussed, as well as **Fig. 7**, where it is illustrated.

In view of the above, the Examiner is respectfully requested to withdraw the objection to the claims.

II. Objection to the Specification

Paragraph 3 of the Office Action states that the amendment to the Specification which was filed on April 24, 2010 is objected to “because it introduces new matter into the disclosure”. In particular, paragraph 3 refers to the amendment of Paragraph [0013] of Applicants’ Specification, which replaces “... the portion may comprise the identified content in its entirety ...” with “... the portion comprises a subset of the identified content ...”. While Applicants do not concede that this narrowing amendment to the Specification introduced new matter, an Amendment to the Specification is provided herein to restore this text to its previous form.

In view of the above, the Examiner is respectfully requested to withdraw the objection to the Specification.

III. Rejection under 35 U. S. C. §101

Paragraph 5 of the Office Action states that Claims 1, 14 - 16, 18, and 22 - 24 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, and paragraph 6 of the Office Action states that these claims are rejected under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention. Paragraph 6 further states that “... the claim(s) could be completely performed mentally, verbally and/or without a machine ...”.²

² Office Action, paragraph 6, lines 7 - 8.

This rejection is respectfully traversed.

Each of the claims rejected in the Office Action under §101 is a method claim. Applicants respectfully disagree that their recited computer-implemented methods³ could be performed mentally, verbally, and/or without a machine. Clearly, the computer is a machine, and because Applicants' method claims are recited as computer-implemented, they are implemented by a machine. These method claims are therefore directed to statutory subject matter.

In addition, in the interest of progressing rapidly to issuance, Applicants have amended Claim 1 to recite “on a graphical user interface device” in the “offering” claim element on lines 9 - 12 of Claim 1, which is a recitation of hardware, as requested in paragraph 6 of the Office Action.

In view of the above, the Examiner is respectfully requested to withdraw the §101 rejection.

IV. Rejection under 35 U. S. C. §103(a)

Paragraph 8 of the Office Action states that Claims 1, 14 - 16, 18, and 20 - 24 are rejected under 35 U. S. C. §103(a) as being unpatentable over U. S. Patent Publication 2004/0043758 to Sorvari et al. (hereinafter, “Sorvari”) in view of U. S. Patent 6,731,393 to Currans et al. (hereinafter, “Currans”). This rejection is respectfully traversed.

³ See Claim 1, line 1. The term computer-implemented is also recited in line 1 of each of the cited dependent Claims 14 - 16, 18, and 22 - 24.

Section 2143.03 of the MPEP, “All Claim Limitations Must Be Considered” (which is found within Section MPEP §2143, titled “Examples of Basic Requirements of a *Prima Facie* Case of Obviousness”), quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added)

Applicants respectfully submit that neither Sorvari nor Currans, nor any combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art was motivated to attempt it), teaches or suggests all words of the claim recitations of their independent Claims 1, 19, and 20 as currently recited, as will now be demonstrated.

Referring first to independent Claim 1, paragraph 16 of the Office Action admits the Sorvari “does not specifically [disclose]” the “and scheduling time on an electronic calendar of the user” claim language which is recited on line 20 of Claim 1. Paragraph 17 of the Office Action then states that this claim language is taught by Currans, referring in particular to col. 12, line 58 - col. 13, line 52 and **Figs. 6 - 8** of Currans. Paragraph 17 then further asserts that the motivation for combining Sorvari and Currans is

... because utilizing a user calendar to have information sent to the user enables the user to dictate when they would receive information and not have information sent every time a match is made from the trigger. This would also lessen the amount of network traffic in a system.

Applicants respectfully disagree with this analysis of Currans as applied to their claim

language. The cited text from Currans discusses periodically sending a document, such as a daily calendar or a newspaper, to a user. **Fig. 7** of Currans shows, by way of example,

- the scheduled delivery for “FILE: DAILYCALENDAR.DOC” at reference number **12000**, indicating that this document will be delivered at 7:00 a.m. on weekdays; and
- the scheduled delivery for “MY PERSONALIZED NEWSPAPER” at reference number **13000**, indicating that this document will be delivered at 1:30 p.m. on weekdays.

Applicants respectfully note that Currans explicitly states, at col. 12, lines 61 - 64, that the delivery of the daily calendar document **12000** was requested by the user (“... a daily calendar ... which the user has requested be printed automatically ... at 7:00 a.m. every weekday morning.”). Currans also explicitly states, at col. 13, lines 18 - 19, that the delivery of the personalized newspaper **13000** was requested by the user (“Our user has requested that document **13000** ... be printed at 6:00 a.m. every day.”). This is not the same as the claim language recited on line 20 of Claim 1, which – when considered in context of all of the words of the “subsequently evaluating ...” claim element on lines 16 - 20 of Claim 1, as required by the above-quoted MPEP §2143.03 – recites automatically [sending ... to the user and] scheduling time on the user’s calendar.

Fig. 7 of Applicants’ drawings illustrates how this automatic scheduling of time on the user’s calendar can be defined as an action to be taken when a subscription match occurs. Notably, the sample display **700** is presented to the user in advance of the subscription match

occurring, so that the user can define the actions in advance. The previously-defined actions – such as scheduling time on the calendar according to the definition at **720** of **Fig. 7** – are then automatically performed when a match occurs. (See paragraphs [0057] - [0061] of Applicants' application as published, which discuss this scenario.)

Furthermore, with reference to the above-quoted text where Currans explicitly recites that the user requests the document delivery for documents **12000** and **13000**, it can be seen that the user has requested the delivery at a particular time of day, on every day or every weekday. This is not the same as Applicants' recited "... automatically ... scheduling time ...", which happens when "the then-current version of the content is considered a match ..." (see Claim 1, lines 17 - 19). That is, Applicants' recited automatic scheduling occurs when content matches, not (in contrast to Currans) when a particular time of day occurs.

Applicants also note that the document-delivery items illustrated in **Fig. 7** of Currans and discussed in the cited text are already-scheduled items from the user's calendar. These already-scheduled items are not the same, and do not teach, Applicants' recited scheduling that occurs, automatically, responsive to determining that a content match is detected. (See, in particular, the "and if so ..." claim language recited on lines 19 - 20 of Claim 1.)

Accordingly, it can be seen that Currans does not teach the claim language recited on line 20 of Claim 1, in sharp contrast to the assertion in paragraph 17 of the Office Action.

With regard to the above-quoted asserted motivation for combining Sorvari and Currans, Applicants respectfully submit that this text suggests that their claim language has been misunderstood or misinterpreted. In particular, Applicants' claim language does not recite "utilizing a user calendar to have information sent to the user". Instead, the "sending" and the "scheduling time" which are recited in the "and if so, automatically ..." claim language on lines 19 - 20 are two distinct actions (i.e., the sending is not recited as occurring at the scheduled time).

Furthermore, whereas the asserted motivation states "enables the user to ... not have information sent every time a match is made" (emphasis added), this is the opposite of what is recited in the "subsequently evaluating ..." claim element on lines 16 - 20 of Claim 1. In sharp contrast to this statement from the Office Action, Claim 1 recites "and if so [i.e., if the then-current version of the content is considered a match], automatically sending the then-current version ... to the user ...". Accordingly, this claim language indicates that the content is sent every time a match is made, in contradiction of the statement in the asserted motivation.

The motivation for combining the references is therefore flawed, and as a result, the Office Action has not met the requirements for establishing a *prima facie* case of obviousness.

For at least the above-stated reasons, Applicants respectfully submit that their independent Claim 1 is patentable over the references. Dependent Claims 14 - 16, 18, and 22 - 24 are therefore deemed patentable at least by virtue of the patentability of Claim 1 from which they depend.

Referring next to independent Claims 20 and 21, these claims are not separately analyzed in the Office Action, and are rejected using the same analysis presented with regard to Claim 1. Office Action, paragraph 9. Accordingly, Applicants respectfully submit that the arguments presented above with regard to Claim 1 apply equally to demonstrate that independent Claims 20 and 21 are patentable over the references.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejection.

V. Added Claim 25

Dependent Claim 25 is added herein, and recites "... a user-defined amount of time is used for the scheduling time on an electronic calendar of the user" (referring to the antecedent on line 20 of Claim 1). See, for example, the drop-down list at **720** of Applicants' **Fig. 7**, which allows the user to select what amount of time will be scheduled on his or her calendar when a content match is subsequently detected. It can be seen that no new matter is introduced with this added claim.

VI. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all currently-presented claims at an early date.

Respectfully submitted,

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